Independent claim 38 recites the preparation of a P-chiral ligand, whereby in step b) an intermediate P-compound is formed, and in step c) this intermediate is converted into the P-chiral ligand.

The Examiner admits (page 5) that Hayashi et al. do not teach a P-chiral ligand ($PR^1R^{1'}$, wherein R^1 and $R^{1'}$ are different from each other, instant step c)) and the formation of an intermediate compound (instant step b)).

Applicants submit that neither Hayashi et al. nor Berlin et al. disclose the aforementioned features of claim 38. In particular, Berlin et al. do not remedy the conceded deficiency of Hayashi et al. for the intermediate compound. Accordingly, the asserted combination of Hayashi et al. and Berlin et al. is deficient.

The feature of step b), i.e. the formation of the intermediate, cannot reasonably be said to be present in the asserted combination of references.

The Examiner ignores the absence of any teaching for step b) and the formation of the intermediate in the cited prior art and continues to argue (by postulating the presence of the intermediate) that Berlin et al. "*teach the reaction of a halogenated phosphine with a Grignard reagent in order to produce a phosphine with different R groups on it. See page 78.*"

The Examiner thereby ignores that the product of the disclosed Grignard reaction is not a chiral phosphine, which is in contrast to the result of instant step c), as the subject-matter of Berlin et al. is a phosphine oxide of type $Ar_2P(O)R$, which is achiral prior to the reaction with the Grignard compound, and remains achiral after the Grignard reaction due to the presence of two identical aryl groups. Further, the Examiner ignores that Berlin et al. clearly teach away from the Grignard reaction, as Berlin et al. state on top of page 79 that "*this second method* [meaning the discussed re-arrangement reaction]*...is to be recommended in preference to the Grignard experiment.*"

Thus, the Examiner isolates from the whole disclosure the Grignard reaction. However, as the invention and the prior art should be considered as a whole, the relevant content of the Berlin et al. paper shows that it a) does not teach the formation of a chiral phosphine, and b) teaches away from using the Grignard reaction.

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the applied references.

The Examiner continues to provisionally reject claims 38-44 for obviousness-type double patenting as being unpatentable over claims 44 and 54-60 of Serial No. 10/586,287. Applicants again kindly request that the Examiner hold this rejection in abeyance, pending an indication that the claims of the present application are otherwise in condition for allowance.

On page 3 of the Office Action, in response to Applicants' previous request to hold the double patenting rejection in abeyance, the Examiner states that he cannot do this as the policy of the PTO is to apply all applicable rejections as early as possible to facilitate compact prosecution.

However, as noted in MPEP 804, section A, where the Examiner becomes aware of two co-pending applications that were filed by the same inventive entity, the courts have sanctioned the practice of making applicants **aware of the potential double patenting problem** if one of the applications became a patent by permitting the examiner to make a "**provisional**" rejection on the ground of double patenting; and moreover, the "provisional" double patenting rejection should continue to be made by the Examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection **is the only rejection remaining** in at least one of the applications. The Examiner has not indicated in an Office Action that the "provisional" double patenting rejection is the only remaining rejection in at least one of the applications. Therefore, the Examiner should continue to make the "provisional" double patenting rejection in subsequent actions.

Further, since the Examiner has made Applicants aware of the "provisional" rejection, no further action is required at this time. "Once the provisional rejection has been made, there is nothing the examiner and the applicant must do until the other application issues." See *In re Mott*, CCPA 1976, 539 F.2d 1291, 190 USPQ (BNA) 536. "There is no question of course, that a double patenting rejection would be proper if one of appellant's applications issues. The effect of our reversal is merely to maintain co-pendency of these claims." The Court further noted that where the PTO refuses to permit further prosecution without performance by the appellant, such as by cancelling, arguing distinctions, or amending the claims, the rejection, in legal effect, is final and improper. Therefore, no action can be taken after a "provisional" rejection has been made unless one of the applications has issued. Since neither applications has issued in the present case, the Examiner cannot properly require Applicants to distinguish or amend the claims or file a Terminal Disclaimer.

Moreover, since amendments may be made to either application during their pendency, the Examiner must wait until one application issues before requiring the filing of a terminal disclaimer. "If a 'provisional' non-statutory obviousness-type double patenting rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later filed application is rejectable on other grounds, the examiner should withdraw the rejection and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer." MPEP 804. Clearly, the MPEP does not require the filing of a Terminal Disclaimer unless one of the applications has issued.

In view of the foregoing, Applicants have made a proper reply in requesting that the provisional double patenting rejection be held in abeyance.

Respectfully submitted,

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